

REMARKS

Claims 1-17 remain pending in this application. Claims 1,7, 10 and 13 are independent. No claims have been added, canceled, or amended by this Response. In view of the following remarks, reconsideration and allowance of claims 1-17 are respectfully requested.

Unpatentability Rejection over Wang et al. in View of Kalmanek, Jr. et al.

Withdrawal of the rejection of claims 1-5, 7-8, 10-11, 13-14, and 16-17 under 35 U.S.C. §103(a) as being unpatentable over Wang et al. ("Wang") (US 6,009,321) in View of newly-cited Kalmanek, Jr. et al. ("Kalmanek '662") (US 7,274,662) is requested. The portions of Kalmanek '662 relied upon by the Examiner in formulating the rejections are not available as "prior art" to the limitations in question, as discussed more fully below.

Applicants note that, to establish a *prima facie* case of obviousness, three basic criteria offer useful insights. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations.¹ Further, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure.² The Supreme Court recently held that it is necessary, *inter alia*, for a court to look to interrelated teachings of multiple patents in order to determine whether there was an apparent reason to combine the known elements in the claimed. In this regard, the Court held "[t]o facilitate review, this analysis should be made explicit."³ "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."⁴

¹ See MPEP §2143.

² *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) and See MPEP §2143.

³ *KSR Int'l. Co. v. Teleflex Inc.*, 550 U.S. ____ (2007) (see p. 14).

⁴ See *Id.*, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

Kalmanek '662 is not "Prior Art" to Examiner-Identified Limitations of Applicants' Claims

As a threshold matter, Kalmanek '662 is not properly available as prior art against the present application in terms of providing a teaching or suggestion of the limitations identified by the Examiner in all claim rejections, discussed further below.

Kalmanek '662 has a filing date of December 22, 1999, whereas the present application is a National Stage entry under the PCT of International Application serial. no. PCT/FI99/00676 filed on August 16, 1999. Thus, the effective U.S. filing date of the present application is August 16, 1999, a date that is before the filing date of Kalmanek '662. Furthermore, the present application has a priority claim under 35 U.S.C. §365 to Applicants' priority Finnish application 981773 filed on August 18, 1998.

Kalmanek '662 purports to claim benefit under 35 U.S.C. §120 as a continuation-in-part (CIP) application of numerous parent applications including U.S. patent application serial nos. 09/366,676, now US patent 6,324,279; 09/366,207, now US patent 6,483,912; 09/366,208, now US patent 6,757,290; 09/366,210, now US patent 6,694,429; and 09/366,678, now US patent 6,870,845.

Kalmanek '662 further purports to claim benefit of provisional application 60/104,878 filed on October 20, 1998, and provisional application 60/095,288, filed on August 4, 1998.

However, Applicants point out that the various claims of benefit and priority made in Kalmanek '662 do not pertain to the limitations of independent claims 1, 7, 10, and 13 which the Examiner asserts are taught by Kalmanek '662 because provisional applications 60/104,878 and 60/095,288 are completely silent on the limitations noted by the Examiner, and do not contain the necessary disclosure to support a rejection.

In fact, it can be seen that the portions cited by the Examiner in Kalmanek '662 (*i.e.*, "8. Lawfully-Authorized Electronic Surveillance" found starting at col. 28, line 56) constitute, at least in part, the "new matter" that was added to Kalmanek '662 during the course of filing one or more CIP applications. Thus, the earliest critical reference dates of the provisional applications, *i.e.*, August 4, 1998 and October 20, 1998 are not available in applying Kalmanek '662 in the rejections of the pending claims in the manner set forth by the Examiner.

Thus, for "prior art" purposes concerning the limitations identified in the present rejections, Kalmanek '662 has a prior art date of December 22, 1999. Accordingly, Kalmanek '662 must be removed as a reference.

Legal Basis for Applicants' Statements Regarding Kalmanek '662

In support of Applicants' legal position, the Examiner's attention is invited to MPEP 2136.03⁵ in which long-existing law and patent practice is discussed that clearly supports Applicant's arguments that the filing date of a parent U.S. Patent Application can only be used as the critical reference date if it supports the claims of the issued child (e.g., Kalmanek '662). See also MPEP § 706.02(f)(1), examples 2 and 5 to 9 for proper determination of 102(e) prior art dates.

As stated in the MPEP, in order to carry back the 35 U.S.C. 102(e) critical date of the U.S. patent reference to the filing date of a parent (e.g., provisional application, the U.S. patent reference must have a right of priority to the earlier date under 35 U.S.C. 120 or 365(c) and the parent application must support the invention claimed as required by 35 U.S.C. 112, first paragraph. "For if a patent could not theoretically have issued the day the application was filed, it is not entitled to be used against another as 'secret prior art' " under 35 U.S.C. 102(e). *In re Wertheim*, 646 F.2d 527, 537, 209 USPQ 554, 564 (CCPA 1981) (The Examiner made a 35 U.S.C. 103 rejection over a U.S. patent to Pfluger.)

In *Wertheim*, the Pfluger patent (Pfluger IV) was the child of a string of abandoned parent applications (Pfluger I, the first application, Pfluger II and III, both CIPs). Pfluger IV was a continuation of Pfluger III. The court characterized the contents of the applications as follows: Pfluger I subject matter A, II-AB, III-ABC, IV-ABC. ABC anticipated the claims of the examined application, but the filing date of III was later than the application filing date. So the examiner reached back to "A" in Pfluger I and combined this disclosure with another reference to establish obviousness. The court in *Wertheim* held that the examiner impermissibly carried over "A" and should have instead determined which of the parent applications contained the subject matter which made Pfluger patentable. Only if B and C were not claimed, or at least not

critical to the patentability of Pfluger IV, could the filing date of Pfluger I be used. The court reversed the rejection based on a determination that Pfluger IV was only entitled to the Pfluger III filing date. The added new matter (C) was critical to the claims of the issued patent.).

Applicants submit that the decision in *Wertheim* is directly on point in the present rejections, and supports their conclusion that Kalmanek '662 is not available as prior art against the present application.

Discussion of the Deficiencies of Wang

As admitted by the Examiner in the Office Action, Wang is deficient in several ways with respect to limitations variously found in each of the independent claims 1, 7, 10, and 13. The Examiner relies upon Kalmanek '662 to overcome the admitted deficiencies of Wang. However, as discussed above, Kalmanek '662 is not available as prior art due to the lack of supporting disclosure in the provisional applications from which benefit is claimed, *i.e.*, the provisional applications do not teach or suggest all the claimed limitations.

Accordingly, withdrawal of the rejection and allowance of claims 1-5, 7-8, 10-11, 13-14, and 16-17 in this application are respectfully requested.

Unpatentability Rejection over Wang and Kalmanek '662 in View of Clarke et al.

Withdrawal of the rejection of claims 6, 9, 12 and 15 under 35 U.S.C. §103(a) as being unpatentable over Wang and Kalmanek '662 in view of Clarke et al. ("Clarke") (US 5793752) is requested.

Even assuming, *arguendo*, that Clarke teaches that for which the Examiner asserts, Kalmanek '662 is not available as prior art against the present application, at least with respect to the limitations noted by the Examiner, such that the applied art does not teach or suggest all the claimed limitations, as discussed above,. Accordingly, the unpatentability rejection of claims 6, 9, 12 and 15 should also be withdrawn.

⁵ MPEP 2136.03 (IV) - "PARENT'S FILING DATE WHEN REFERENCE IS A CONTINUATION-IN-PART OF THE PARENT - Filing Date of U.S. Parent Application Can Only Be Used as the 35 U.S.C. 102(e) Date If It Supports the Claims of the Issued Child".

Conclusion

In view of the above remarks and legal arguments, Applicants submit that each of pending claims 1-17 in this application is in immediate condition for allowance. An early indication of the same would be appreciated.

In the event the Examiner believes an interview might serve to advance the prosecution of this application in any way, the undersigned attorney is available at the telephone number indicated below.

For any fees that are due, including fees for extensions of time, the Director is hereby authorized to charge any fees or credit any overpayment during the pendency of this application to Deposit Account No. 03-3975, under Order No. 060258-0277084 from which the Undersigned Attorney is authorized to draw.

Date: May 16, 2008

Respectfully submitted,

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